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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.       | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------------|------------------|
| 10/687,656  | 10/20/2003  | Koichi Otsuki        | 241333US-4946-4947-2-CONT | 4418             |
| 22850   | 7590        | 09/22/2004           |                           |                  |
| OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.<br>1940 DUKE STREET<br>ALEXANDRIA, VA 22314 |             |                      | EXAMINER<br>NGUYEN, LAM S |                  |
|   |             |                      | ART UNIT<br>2853          | PAPER NUMBER     |

DATE MAILED: 09/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/687,656

Applicant(s)

OTSUKI ET AL.

Examiner

LAM S NGUYEN

Art Unit

2853

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 38-74 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 38,44-49 and 52-74 is/are allowed.
- 6) ☒ Claim(s) 39-43 and 50 is/are rejected.
- 7) ☒ Claim(s) 51 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☒ Certified copies of the priority documents have been received in Application No. 09/497,168.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>07/13/2004</u> . | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

The terminal disclaimer filed on 08/24/2004 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US 6692096 has been reviewed and is accepted. The terminal disclaimer has been recorded. However, there are claims that claim the same invention in the application and the above patent, the rejection below is a statutory type double patenting that cannot be overcome by the terminal disclaimer.

#### *Double Patenting*

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

#### Note:

\_ In the application and the patent, a value used "to reduce printing position deviation arising between the forward and reserve main scanning passes" is named differently such as "a bi-directional printing position adjustment value" (in the application) and "an adjustment value" (in the patent), they both are identical as based on their functions.

\_ Similarly, in the application and the patent, a value defined as “a correction value for correcting a relative printing positional deviation of another row against the reference row” is named differently such as “a relative position correction value” (in the application) and “a relative correction value” (in the patent), they both are identical as based on the definition.

In addition, eventhough the conflicting claims are not exact the same in defining “a relative position correction value for correcting the reference value with respect to a bi-directional printing position deviation”, the claims define “a reference correction value for correcting the printing positional deviation arising between the forward and reverse main scanning passes”. Therefore, the relative position correction value for correcting the reference value must respect to the bi-directional printing position deviation.

Therefore, the claims are claiming the same invention; as a result, the statutory type double patenting rejections are made as follows:

Claim 39 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 1 of prior U.S. Patent No. 6692096. This is a double patenting rejection.

Claim 40 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 2 of prior U.S. Patent No. 6692096. This is a double patenting rejection.

Claim 41 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 3 of prior U.S. Patent No. 6692096. This is a double patenting rejection.

Claim 42 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 4 of prior U.S. Patent No. 6692096. This is a double patenting rejection.

Claim 43 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 5 of prior U.S. Patent No. 6692096. This is a double patenting rejection.

Claim 50 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 16 of prior U.S. Patent No. 6692096. This is a double patenting rejection.

***Allowable Subject Matter***

Claims 38, 44-49, 51-74 are allowed and claim 51 is objected to as being dependent upon a rejected base claim 50, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

**Referring to claim 38, 57, and 74:** The primary reasons for the indication of the allowability of claims 38, 57, and 74 is the inclusions therein, in combination as currently claimed, of the limitation that a relative position correction value prepared beforehand for correcting the reference correction value with respect to a bi-directional printing position deviation is neither disclosed nor taught by the cited prior art of record, alone or in combination.

Claims 44-49, 52-56, and 58-73 are allowed because they depend directly/indirectly on claim 38 or 57.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LAM S NGUYEN whose telephone number is (571)272-2151. The examiner can normally be reached on 7:00AM - 3:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, STEPHEN D MEIER can be reached on (571)272-2149. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2853

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LN  
September 16, 2004



**HAI PHAM**  
**PRIMARY EXAMINER**